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Baker 19-3

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EXAMINER

TODD, GREGORY G

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERT D. BAKER and RICHARD KWOKCHIU

Appeal 2009-000547
Application 09/484,098
Technology Center 2400

Decided:¹ July 30, 2009

Before KENNETH W. HAIRSTON, MAHSHID D. SAADAT, and KARL
D. EASTHOM, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1 to 21. We have jurisdiction under 35 U.S.C. § 6(b).

We will reverse the rejections.

Appellants have invented a method and an apparatus that use a gateway coupled between a local network and one or more external networks to determine remotely assigned address information for a given device attached to the local network, and to establish, based at least in part on the remotely assigned address information, a substitution address for use by at least one other device attached to the local network when communicating with the given device (Figs. 1, 3; Spec. 4 to 6; Abstract).

Claim 1 is representative of the claims on appeal, and it reads as follows:

1. An apparatus for use in interfacing a local network to one or more external network elements, the apparatus comprising:
a gateway coupled between the local network and the one or more external network elements, the gateway being operative to determine remotely-assigned address information for a given device attached to the local network; and to establish, based at least in part on the remotely-assigned address information, a substitution address for use by at least one other device attached to the local network when communicating with the given device.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kondo	US 6,088,725	Jul. 11, 2000 (filed Aug. 1, 1997)
Gelman	US 6,493,348 B1	Dec. 10, 2002 (filed Dec. 2, 1998)

The Examiner rejected claims 1 to 3, 5 to 13, and 15 to 21 under 35 U.S.C. § 102(e) based upon the teachings of Kondo.

The Examiner rejected claims 4 and 14 under 35 U.S.C. § 103(a) based upon the teachings of Kondo and Gelman.

The Examiner contends that the claimed invention set forth in claims 1 to 3, 5 to 13, and 15 to 21 is anticipated by the teachings of Kondo because “Kondo teaches an AMS [address mapping server] (Fig. 1, 11; 102) being coupled between the LAN [local area network] (105) and the Internet (106) via an external network *element* (router, 103)” (Ans. 7). In response, Appellants argue (Reply Br. 2) “[i]t is readily apparent from a comparison of FIG. 1 of the present application with FIG. 1 of Kondo that in the former, gateway 110 is coupled between LAN 102 and elements of external networks 114 and 116, while in the latter, AMS 102 of Kondo is not coupled between LAN 105a and any external network element”

ISSUES

Anticipation

Have Appellants shown that the Examiner erred by finding that the AMS in Kondo is between the LAN and an external network?

Obviousness

Have Appellants demonstrated that the Examiner erred by finding that the combined teachings of the references render obvious the claimed invention?

FINDINGS OF FACT (FF)

1. Figure 1 of Appellants’ drawing shows the gateway 110 between the LAN 102 and the external networks 114 and 116.

2. Figure 1 of Kondo shows the router 103 between the LANs and the external network (i.e., Internet 106). The AMS 102 is in parallel with the PCs on the LAN.

3. The router 103 in Kondo is coupled between the LAN and the external network 106.

4. Gelman describes an asymmetric digital subscriber line (ADSL) connected to ATU-R devices (col. 6, ll. 15 to 35).

PRINCIPLES OF LAW

Anticipation

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

Obviousness

The Examiner bears the initial burden of presenting a prima facie case of obviousness, and the Appellants have the burden of presenting a rebuttal to the prima facie case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Anticipation

In Kondo, the AMS 102 is connected in parallel with the PCs on the LAN, and it is not connected between the LAN and the external network 106 (FF 2). Although the router 103 in Kondo is coupled between the LAN and the external network 106 (FF 3), the router does not perform any of the functions set forth in each of the claims on appeal. Thus, we agree with Appellants' argument (App. Br. 9) that "the AMS 102 is an element of the local network itself, and not a gateway that is coupled between a local

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network and one or more external network elements” as recited in the claims on appeal. It follows that anticipation has not been established by the Examiner because Kondo does not disclose each and every limitation of the claimed invention set forth in claims 1 to 3, 5 to 13, and 15 to 21. *Atlas Powder Co.*, 190 F.3d at 1347; *Paulsen*, 30 F.3d at 1478-79.

Obviousness

A prima facie case of obviousness of the claimed subject matter set forth in dependent claims 4 and 14 has not been established by the Examiner because the teachings of the reference to Gelman (FF4) fail to cure the noted shortcoming in the teachings of Kondo. *Oetiker*, 977 F.2d at 1445.

CONCLUSIONS OF LAW

Anticipation

Appellants have demonstrated that the Examiner erred by finding that the AMS in Kondo is between the LAN and an external network.

Obviousness

Appellants have demonstrated that the Examiner erred by finding that the combined teachings of the references render obvious the claimed invention.

ORDER

The decision of the Examiner rejecting claims 1 to 3, 5 to 13, and 15 to 21 under 35 U.S.C. § 102(e) is reversed. The decision of the Examiner rejecting claims 4 and 14 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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gvw

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